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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/526,981	06/07/2005	Philip Summersgill	P70416USD	7989
136 7590 05/08/2009 JACOBSON HOLMAN PLLC 400 SEVENTH STREET N.W. SUITE 600 WASHINGTON, DC 20004				
EXAMINER ALEXANDER, LYLE				
ART UNIT		PAPER NUMBER		
1797				
MAIL DATE		DELIVERY MODE		
05/08/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/526,981

**Applicant(s)**

SUMMERSGILL ET AL.

**Examiner**

Lyle A. Alexander

**Art Unit**

1797

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 February 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4, 6, 7, 10, 11, 13, 16, 19 and 20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-7, 10-11, 13, 16 and 19-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

***Claim Rejections - 35 USC § 102***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1,6-7, 10 rejected under 35 U.S.C. 102(b) as being clearly anticipated by Cherukuni et al.

See the appropriate paragraph of the 8/19/08 Office action.

The 2/19/09 amendments have added the new limitations "said ferrule being resilient at least in the region fluid-tight connections." The Office maintains this language is sufficiently broad that it has been properly read on Cherukuni et al. Cherukuni et al. teach fluid tight connections that facilitate the fluid flow. This has been properly read on the new claim language.

Claims 1-4, 6-7,10-11, 13, 16 and 19-20 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by DE 19928412.

See Applicant's 2/19/09 request to consider this reference in light of the IPER document submitted 2/19/09.

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 2,11 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cherukuni et al. in view of Berndt et al.

See the appropriate paragraph of the 8/19/08 Office action.

The 2/19/09 amendments have added the new limitations that different parts of the device are fabricated from different materials and the ferrule is a PTFE tube.

MPEP 2144.07 teaches The selection of a known material based on its suitability for its intended use supported a prima facie obviousness determination in *Sinclair & Carroll Co. v. Interchemical Corp.*, 325 U.S. 327, 65 USPQ 297 (1945). Also In *re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960) (selection of a known plastic to make a container of a type made of plastics prior to the invention was held to be obvious); *Ryco, Inc. v. Ag-Bag Corp.*, 857 F.2d 1418, 8 USPQ2d 1323 (Fed. Cir. 1988).

It would have been desirable to make the device taught by Cherukuni et al. in view of Benett et al. from different materials to gain the advantages of different heat transfer characteristics. Additionally, PTFE is notoriously well known in the art as a desirable plastic because it is inexpensive, readily available and inert. It would have been within the skill of the art to further modify Cherukuni et al. in view of Benett et al. and use different material of construction for different regions of the device and use PTFE to gain the above advantages and as selection of a material based upon its suitability of intended use.

Claims 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cherukuni et al. in view of Berndt et al. as applied to claims 2 and 11 above, and further in view of Benett et al.

See the appropriate paragraph of the 8/19/08 Office action.

The 2/19/09 amendments are sufficiently broad to have not changed the scope of the pending claims or the rejections of record.

Claims 4 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cherukuni et al. in view of Benett et al.

See the appropriate paragraph of the 8/19/08 Office action.

The 2/19/09 amendments are sufficiently broad to have not changed the scope of the pending claims or the rejections of record.

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cherukuni et al. in view of Benett et al. as applied to claims 4 and 13 above, and further in view of Jovanovich et al.

See the appropriate paragraph of the 8/19/08 Office action.

The 2/19/09 amendments are sufficiently broad to have not changed the scope of the pending claims or the rejections of record.

Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cherukuni et al. in view of Benett et al. as applied to claim 16 above, and further in view of Strand et al.

See the appropriate paragraph of the 8/19/08 Office action.

The 2/19/09 amendments have added the new limitations "said ferrule being resilient at least in the region fluid-tight connections." The Office maintains this language is sufficiently broad that it has been properly read on Cherukuni et al. Cherukuni et al. teach fluid tight connections that facilitate the fluid flow. This has been properly read on the new claim language.

***Response to Arguments***

Applicant's arguments filed 2/19/09 have been fully considered but they are not persuasive.

Applicant's have requested the Office to considered DE 19928412 in light of the attached IPER document. The Office will accept the IPER document as Applicant's characterization of DE 19928412 in the absence of a translation or any other characterization.

Applicant states Cherukuni et al. fail to teach the presently claimed rigid tubular elements. The Office maintains this language is sufficiently broad to have been properly read on the cited prior art. Clearly Cherukuni et al. teach tubular wells(340), etc. and these wells are clearly "rigid."

Applicant argues the combination of Cherukuni et al. in view of Benett et al. would not teach the claimed fluid tight resilient connections. Again, the Office maintains this claim language is sufficiently broad to have been properly read on the prior art which clearly teaches fluid tight resilient connections.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lyle A. Alexander whose telephone number is 571-272-1254. The examiner can normally be reached on Monday, Tuesday and Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Lyle A Alexander  
Primary Examiner  
Art Unit 1797

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Primary Examiner, Art Unit 1797